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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/523,600

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Adolf-Gustav Zajber

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5833

40570

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04/04/2008

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EXAMINER

KERNS, KEVIN P

ART UNIT

PAPER NUMBER

1793

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/523,600	<b>Applicant(s)</b> ZAJBER ET AL.	
	<b>Examiner</b> Kevin P. Kerns	<b>Art Unit</b> 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2008 and 28 January 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☒ Claim(s) 1,3 and 5-10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: “20” (see specification, page 7, line 16). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: “28” (see Figure 3). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing

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date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

In this instance, the abstract includes the legal terms "comprises", "means", and "said". Appropriate corrections are required.

4. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

(a) TITLE OF THE INVENTION.

- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A “Sequence Listing” is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required “Sequence Listing” is not submitted as an electronic document on compact disc).

In this instance, the specification lacks section headings.

### ***Claim Objections***

5. Claims 1, 3, and 5-10 are objected to because of the following informalities: in claim 1, 1<sup>st</sup> line, delete “the” before “dynamic” to obtain proper antecedent basis. In claim 1, 10<sup>th</sup> line, delete “the” before “hydraulic” to obtain proper antecedent basis. In claim 1, 14<sup>th</sup> line, delete “the” after “in” for clarity. In claim 1, 14<sup>th</sup> and 15<sup>th</sup> lines, delete “the” before “hot” and “soft”, respectively, to obtain proper antecedent basis. In claim 1, 15<sup>th</sup> line, delete “,” after “bar zone”. In claim 3, 3<sup>rd</sup> line, delete “the” before “continuously” to obtain proper antecedent basis. In claims 5 and 10, 2<sup>nd</sup> lines of both claims, replace “the” with “a” before “drive” to obtain proper antecedent basis. In claim 5, 2<sup>nd</sup> line, replace “(31)” with “(29)”. In claim 6, 2<sup>nd</sup> line, replace “the” with “an” before

“adjustment” to obtain proper antecedent basis. In claim 6, 3<sup>rd</sup> line, delete “the” before “dynamic” to obtain proper antecedent basis. In claims 7 and 8, 3<sup>rd</sup> lines of both claims, replace “the” with “a” before “given” to obtain proper antecedent basis. In claim 9, 4<sup>th</sup> line, replace “the” with “a” before “piston” to obtain proper antecedent basis. In claim 10, 3<sup>rd</sup> line, replace “the” with “a” before “basic” to obtain proper antecedent basis. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by “such as” and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required

feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad recitation “metal”, and the claim also recites “especially steel” which is the narrower statement of the range/limitation.

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-4 and 6-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Weyer et al. (US 6,386,268).

As to claim 1, Weyer et al. disclose a method for adjusting roller segments comprising the steps of adjusting rollers (3) relative to each other by both position control and pressure control. The rollers (3) are adjusted from position control to pressure control when the hydraulic pressure in the piston-cylinder unit reaches a predetermined value (abstract; and Figures 1 and 2). As to claims 2 and 4, the driven rollers (the last roller of the set of rollers 3) are arranged on the segment exit side and include a switching operation. As to claim 3, a containment roll stand is arranged after the bending-straightening unit, having hydraulics piston-cylinder assembly with position and pressure controlled devices (Figures 1 and 2). As to claim 6, the control systems

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are capable of calculating the adjustment of the hydraulics and automatically control the hydraulics. As to claims 7 and 8, the control systems are capable of controlling the hydraulics by calculating roll spring compensation, minimum/maximum force regulator, positioning, torque, and speed. As to claim 9, Weyer et al teach both pressure and position sensors (abstract; column 2, lines 17-67; column 3, lines 1-30; and Figures 1 and 2).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).



12. Claims 5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weyer et al. (US 6,386,268).

Weyer et al. disclose the above invention as claimed, but fail to teach that the drive motor for a driven motor is arranged, together with a transfer case, on one side of the segment frame with a vertical drive shaft orientation. However, it would have been obvious to one of ordinary skill in the art to arrange the drive motor together with the transfer case on one side of the frame, since this would depend on the design expediency. As to claim 10, Weyer et al. fail to teach that the drive motor for the driven motor communicates with the basic automation system. However, it would have been obvious to connect the drive motor to the automation system, since the entire device is driven automatically.

### ***Response to Arguments***

13. The examiner acknowledges the applicants' after final amendment entered upon filing of the request for continued examination, which were received by the USPTO on January 7, 2008 and January 28, 2008, respectively. Upon review, new objections to the drawings, abstract, specification, and claims, as well as new 35 USC 112, 2<sup>nd</sup> paragraph rejections, are raised in above sections 1-7. Claims 1-10 remain under consideration in the application.

14. Applicants' arguments filed January 7, 2008 have been fully considered but they are not persuasive.

With regard to the applicants' remarks/arguments on pages 7 and 8 of the amendment of January 7, 2008, the applicants' major argument is that Weyer et al. allegedly do not disclose and/or suggest "the hot bar zone and/or the soft reduction zone". The examiner respectfully disagrees with this argument. First, the method and continuous casting device of Weyer et al. are used for adjusting an installation roll segment for use in billet casting, and the automatic segment control system and basic automation system are disclosed in the form of a combination of hydraulic cylinder units (8,11) assigned with pressure sensors (12,13) and locators 14, in which their output signals are transmitted to a computer unit 15 (see column 2, lines 34-62; and Figures 1 and 2). Second, the supporting zone 4 is soft reduction zone that contains solidified billet 5, and independent claim 1 only broadly recites "*the hot bar zone and/or the soft reduction zone*". In other words, only one of the two zones is required to read on the claim, due to the broadly inclusive term "and/or". The cold zone as described in Weyer et al. can be interpreted as a soft reduction zone, since the metal is still in the compressible state. As a result, claims 1-10 remain rejected.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kevin P. Kerns whose telephone number is (571)272-1178. The examiner can normally be reached on Monday-Friday from 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Primary Examiner  
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Primary Examiner, Art Unit 1793  
February 23, 2008